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In re Application of : **OFFICE OF PETITIONS**
Orlowski et al. :
Application No. 09/428,982 : **ON PETITION**
Filed: 28 October, 1999 :
Attorney Docket No. 35.C8745-CI :

This is a decision on the petition to revive the above-identified abandoned application under 37 CFR 1.137(b),¹ filed on 29 January, 2002.

The petition under 37 CFR 1.137(b) is **GRANTED**.

This application became abandoned on 21 March, 2001, for failure to file a timely response to the non-final Office action mailed on 20 December, 2000, which set a three (3) month shortened statutory period for reply. A request for a Continued Prosecution Application (CPA) was filed on 19 June, 2001. On 18

¹Effective December 1, 1997, the provisions of 37 CFR 1.137(b) now provide that where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to 37 CFR 1.137(b). A grantable petition filed under the provisions of 37 CFR 1.137(b) must be accompanied by:

(1) the required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof. In an application abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

(2) the petition fee as set forth in 37 CFR 1.17(m);

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c)).

June, 2001, a Notice of Improper CPA Filing under 37 CFR 1.53(d) was mailed, informing applicants that the CPA filed on 19 June, 2001, was improper because it was not accompanied by the appropriate extension of time fee necessary for copendency with the prior application. On 21 November, 2001, petitioners submitted a request for a three (3) month time extension, accompanied by the requisite fee. The time extension was not entered, however, and the fee returned, because the request was untimely. On 24 January, 2002, Notice of Abandonment was mailed. On 29 January, 2002, the present petition, accompanied by an amendment, was filed.

It is noted that the prior application became abandoned for failure to timely reply to the non-final Office action mailed on 20 December, 2001, which set a three (3) month shortened statutory period for reply. No extensions of time in accordance with 37 CFR 1.136(a) were obtained. Therefore, the application became abandoned as a matter of law on 21 March, 2001.² Therefore, the CPA filed on 19 June, 2001, was **untimely**. As the Office was prohibited by statute from extending the period for reply, the Notice of Improper CPA Filing was itself improper and is hereby vacated. The Office apologizes for the error and regrets any inconvenience to petitioner.

Since this application is revived for purposes of continuity only with the Continued Prosecution Application (CPA) filed on 19 June, 2001, and since continuity has been established by this decision reviving the application, the application is again abandoned in favor of the above-referenced CPA.

This application is being forwarded to Technology Center 3600 for processing of the CPA filed on 19 June, 2001, and the preliminary amendment filed on 29 January, 2002.

Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.



Douglas I. Wood
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

²35 U.S.C. § 133.